REMARKS

Claims 1 - 7 remain active in this application. No amendments have been presented and no new matter has been introduced into the application.

Claims 1 - 7 have been rejected under 35 U.S.C. §103 as being unpatentable over Puram et al. This ground of rejection is respectfully traversed since Puram et al. is not seen to contain the teachings or suggestions which the Examiner attributes to it, as will be discussed in detail below, and, in fact, is very different in constitution and purpose from the present invention as claimed.

The invention is a computer-implemented skills matching application (SMA) which facilitates and expedites communications which involve the matching of employer requirements with skills of candidates which may be proposed by suppliers and is not primarily involved with performing the actual matching of skills of potential employees with employer requirements. It is important to note, in this regard, that the combination of skills required by a potential employer and the skills possessed by potential candidates may be very complex and require complex communications to convey with sufficient accuracy. The communication process and its complexity often requires an increased number of communications and an extended period of time to result in the identification of suitable candidates and a selection of candidate(s) together with actual procurement of the services of the selected candidate(s). Moreover, in the environment contemplated by the present invention, the communications are further complicated by the interposition of a supplier acting as an intermediary between the potential employer and potential candidates; the supplier being primarily responsible for performing the actual skills matching function.

The problem addressed by the invention is that employer needs for temporary services are often immediate and are not readily accommodated by conventional communications and the invention is directed to facilitating needed communications end-to-end across the entire transaction (e.g. from initial request through candidate selection and/or service procurement) to expedite the communication process and improve its accuracy sufficiently to accommodate the *immediacy* of employer needs. In other words, the invention is principally intended to function as a "front-end" for any manual or computer-based matching system (e.g. head-hunter or head hunting system, such as the system of Puram et al. which, while disclosed in terms of matching directly between a potential employer and potential candidates, appears equally usable for matching between a supplier and candidates, although it is unclear how Puram et al. could accommodate the claimed "statement of work", as will be discussed below) which greatly improves the performance of the overall matching process particularly in regard to accuracy of the matching and timeliness of the response and completion of instances of the service procurement process.

In the following excerpts from the declaration of co-inventor Parks, filed February 12, 2003, the declarant inventor describes the invention as follows (emphasis added):

"Briefly described, the invention disclosed therein relates to a Skills Matching Application or SMA application or tool. The SMA application is a *tool* that allows a user, such as a hiring manager, *to communicate requirements to technical service suppliers in a way that significantly reduces the process time and improves the accuracy of requests sent to*

suppliers. While methods have been developed to procure components and hardware in manufacturing many products, including for example automobiles and computers, the procurement of services, and especially technical services, has not received the same attention. Prior to the present invention, the process was still a matter of advertising, using third party employment services and other intermediaries. The SMA application *provides a way to timely respond to a specific, immediate although temporary need for technical services."*

*   *   *

"The SMA tool is designed to buy services versus products. The response to each request will be the resume of a different person. But by design, the Job Descriptions within the SMA application for that skill type are defined to describe very specific Type of Skills. For example, we have a Skill Type "Programmer" which is supported by a specific job description. Then within that "Programmer" job description, there are several levels of expertise. When a requester needs to hire a "Programmer", the requester selects the specific job description, then defines the customizable attributes of that programmer. A good analogy is buying a car. You go shopping for a Ford Mustang Convertible, then you customize the color, engine, etc. The process is very much repeatable as you are limited to buying the Skill Types defined to the SMA application."

*   *   *

and

"[T]he SAM application of the claimed
invention differs from all other
applications of this type in that it
supports the end-to-end process of buying
services. ... "Skills matching as claimed
in this patent application *differs* in that
first it is a proprietary system. IBM
Corporation has core suppliers of services
that are allowed to receive requirements
from the SMA tool. The SMA tool has pre-
negotiated cap rates and job skills defined
to the system. The *suppliers are responding
to the Request for Service* (RFS), and in
most cases supply that service at or below
the negotiated price. If a supplier
responds above a negotiated rate, the SMA
tool notifies the IBM buyers of the service.
The *SMA tool then creates a means for the
requester and supplier to interact* on the
RFS. When a candidate is finally chosen, *the
SMA application creates the appropriate data
transaction to create an IBM Purchase
Requisition* within the IBM Requisition Tool
Request Category. This process *is
facilitated in that the SMA tool will
designate the rate as a BUYERLESS
transaction* and, once management and
financial approvals are provided, *the
Purchase Order is transmitted.*"

The emphasis of the invention on improving
timeliness, accuracy and completeness of
communications and accommodating an environment where
suppliers are interposed in the communications process
is believed to be well-represented in the preambles of
the independent claims of the application as follows
(emphasis added):

1.   "A Skills Matching Application (SMA)
which *allows a user to communicate
requirements* to technical service *suppliers*
in a way that significantly *reduces the
process time* and *improves the accuracy of
requests* sent to *suppliers"*

4.   "A Web-based Skills Matching
Application (SMA) which *allows a user to
communicate requirements* to *technical
service suppliers* in a way that
significantly *reduces the process time* and
improves the accuracy of requests sent to
suppliers"

5.   A computer system running Skills
Matching Application (SMA) which *allows a
user to communicate requirements* to
technical service suppliers in a way that
significantly *reduces the process time* and
improves the accuracy of requests sent to
suppliers".

Virtually all other elements in the respective
independent and dependent claims are principally
directed to communications, as well, as will be
discussed in greater detail below.

It is believed important, in this regard to note
the latter stages of the prosecution history of this
application. Specifically, claims 1 - 7 were
previously rejected under 35 U.S.C. §102 as being
anticipated by Puram et al. (the same reference at
issue in the present ground of rejection). Appeal was
taken and, in the Decision of the Board of Patent
Appeals and Interferences, after discounting some
arguments made by Appellants as not supported by the
claim language, found that Puram et al. did not teach

communication of notices of requests to suppliers
entered into the SMA by e-mail and thus reversed the
ground of rejection asserted by the Examiner. It is
important to note that the Decision on Appeal *does not*
indicate that any other of the claimed elements were,
in fact, found to be present in Puram et al. Further,
while having the authority to do so, the Board of
Patent Appeals and Interferences declined to make any
rejection under 37 C.F.R. §1.196(b); evidently
deferring to the Examiner to apply the level of
ordinary skill in the art in regard to the claimed
subject matter as a whole although mentioning only the
possibility of obviousness of the element, *per se*, as
to which Puram et al. was found to be deficient. It
is respectfully submitted, as will now be discussed,
that the Examiner has, in fact, failed to consider the
claimed subject matter as a whole and has arrived at
an erroneous conclusion of obviousness even in regard
to the narrow issue of certain communications being
performed by e-mail which, even if obvious, does not,
in and of itself, establish obviousness of the claimed
subject matter as a whole.

Specifically, each of independent claims 1, 4 and
5 contain a recitation substantially to the effect of:

"means for *accessing* the SMA *from a*
Requisition/Catalog (REQ/CAT)application"
(claim 1, emphasis added - claim 4
additionally includes the term "web-based")

This means automatically invokes the SMA application
from another application which is accessed when a need
for services procurement is evident to, for example, a
project manager, hiring manager or the like. This
means and function supports transition from an
intranet supported application to an application
allowing internet communications or a web site
specific to the application in accordance with the
invention. No remotely corresponding structure or

function is seen in Puram et al.

    Further, each independent claim recites (emphasis added):

Claim 1:

    "means for *prompting a user through a series of screens* to enter a *Statement of Work (SOW)* and complete a *skills detail checklist* for *each of the technical skills requested*",

Claim 4:

    "means for *prompting the user through a series of screens in the SMA Web site* to enter a *Statement of Work (SOW)* and complete a *skills detail checklist for each of the technical skills requested*", or

Claim 5:

    "a display system for *prompting a user through a series of screens* to enter a *Statement of Work (SOW)* and complete a *skills detail checklist for each of the technical skills requested*"

These claim recitations support the collection of statements of the requirements of the potential employer of increased completeness and *specific to each required skill* and also of the particulars of the work to be performed. While Puram et al. provides interfaces for the potential employer and candidates (and a third-party evaluator), the interfaces are only generally described and examples provided are in the form of generalized lists simply divided by categories. Nothing in Puram et al. is seen to even remotely answer the provision for entry of a statement of work (SOW) or the "skills detail checklist" much less "for each of the technical skills requested".
The interfaces of Puram et al. seem to be principally

directed to facilitating the scoring of potential matches rather than developing an initial communication which is as complete and specific to the needed work as possible to support an improved response when matching is performed.

Additionally, each of the independent claims recites (emphasis added):

Claim 1:

> "means for submitting the request to contracted suppliers by e-mail notification notifying the supplier that a new request has been entered into the SMA application for them to review and submit a candidate against"

Claim 4:

> "means for submitting the request to contracted suppliers who are sent an e-mail notification notifying the supplier that a new request has been entered into the SMA application for them to review and submit a candidate against", and

Claim 5:

> "transmitting means for submitting the request to contracted suppliers by e-mail notification notifying the supplier that a new request has been entered into the SMA application for them to review and submit a candidate against".

Teachings answering these recitations were found to be absent from Puram et al. in the Decision on Appeal. However, even though the Board of Patent Appeals and Interferences discounted the arguments made concerning the proprietary nature of the invention, pre-negotiated rates and the absence of a database, it is

these recitations which allow the invention to be
implemented in a proprietary fashion based on pre-
existing agreements and without need for access to a
database. That is, the request for services is not
broadcast or even transmitted to a database but only a
notification of a request for services being entered
in the SMA application is sent (e.g. to selected
suppliers who have already agreed to certain terms and
conditions, such as compensation rates, of employment
of candidates who might be selected by the potential
employer) upon such entry into the SMA application.
This procedure provides several important security
features in that it allows the potential employer to
limit the suppliers to which the notice is provided
and the dissemination of information about the
potential employer's needs and supports the automation
of the completion of the service procurement process
once a candidate has been selected based on pre-
existing agreements. The feature also tends to
effectively limit responses from suppliers who might
be only able to respond with marginally qualified
candidates, especially from automated "head-hunting"
systems such as Puram et al. While normal
authorization and authentication procedures may be
applied and are suggested in Puram et al., Puram et
al. does not provide for storage of the request and
transmittal on request of a supplier upon response to
an e-mail notification or otherwise support the
effects of this recitation in the overall combination
of elements claimed.

    Therefore, in direct response to the Examiner's
position in regard to this element of the claimed
combination(s), the issue is not simply whether or not
an e-mail notification would be obvious over an
internet accessible web site as in Puram et al. but
whether or not Puram et al. teaches or suggests (or
provides evidence of a level of ordinary skill in the

art which would support a conclusion of obviousness) that such a particular generation and routing of communications, first by e-mail notification and, in response, contacting a web-accessible server to obtain the services request could provide such enhancements to the communication and selection processes. It is respectfully submitted that, in this proper context of the overall combination of elements which Puram et al. similarly does not teach or suggest, that Puram et al. does not do so. That this is true is particularly evident from the fact that, if Puram et al. were to be used by the supplier for matching service requests to a database of candidates, the supplier would be inputting the service request to the system of Puram et al. rather than retrieving it. Conversely, in the context of the potential employer using the system of Puram et al., the claimed e-mail notification would serve no useful purpose because no supplier is involved or can be accommodated in the system of Puram et al. (since the database of Puram et al. is intended to directly match candidate information with candidate information) and any notification to a web server performing a matching function would be unlikely to be done by e-mail since it apparently would unnecessarily increase the number of communications made between the potential employer and the server and require administrator intervention at the server. Therefore, it is respectfully submitted that the Examiner's conclusion of obviousness of an e-mail notification over a web-accessible server is clearly incorrect even outside the proper context of the remainder of the claimed subject matter.

Moreover, each of the independent claims also contains further recitations involving supplier response as follows (emphasis added):

Claim 1:

"means for receiving *from a supplier* a
candidate or candidates with appended
resumes as appropriate; and

"means for displaying for the user *the
supplier responses* and associated resumes",

Claim 4:

"means for providing *by a supplier* a
candidate or candidates by accessing the SMA
Web site and submitting candidates and
appending resumes as appropriate; and

"means for viewing by the user *the
supplier responses* and associated resumes
and either accepting or rejecting each
candidate submitted", or

Claim 5:

"receiving means for receiving *from a
supplier* a candidate or candidates with
appended resumes as appropriate, said
display system displaying for the user *the
supplier responses* and associated resumes

These recitations are not and cannot be answered by
Puram et al. for the simple reason that a supplier
interposed between the potential employer and the
candidates is not accommodated by the system of Puram
et al. and the recitation inherently could not be
answered by Puram et al. if the system of Puram et al.
were to be used *by* a supplier to obtain matches to be
returned to the application in accordance with the
invention.

Claims 2 and 6 and claims 3 and 7 contain
substantially parallel recitations of the SMA site
being Web-based for providing *supplier* access and
provision of approval and procurement processes in the
combination of the invention. Neither of these

features are taught, suggested or even remotely
appropriate in Puram et al.; providing no useful
function therein. As to claims 2 and 6, the Examiner
is evidently identifying the suppliers and candidates
as a single entity which is contrary to the
recitations of the independent claims and does not
provide the meritorious effects of supporting reliance
upon established advance agreements with suppliers.
As to claims 3 and 7, the passages relied upon by the
Examiner do not mention procurement, much less an
automated process therefor.

Accordingly, in summary, it is seen that Puram et
al. does not in fact, teach or suggest *any* of the
recited elements of any claim or provide evidence of a
level of ordinary skill in the art which would support
a conclusion of obvious in regard thereto, especially
considered as a whole in combination. Clearly, Puram
et al. does not lead to an expectation of success in
simultaneously expediting and improving the accuracy,
completeness and efficiency of *communications*
involving matching of candidate skills and technical
requirements as distinct from performance of the
matching operations. In this regard, it is
respectfully submitted that the Examiner (and the
Board of Patent Appeals and Interferences) may have
been somewhat confused by the Title of this patent
application and the name of the invention as to its
principal function. However, it is respectfully
submitted that the Title and name are not
misdescriptive since the invention is, in fact, an
"application" for "skills matching" in that it
expedites communications involved therein, as is
abundantly evident from the recitations in the claims
of a plurality of elements directed to communication
operations, in combination, rather than matching
functions, as discussed above. The invention is
principally a "front end" for interfacing between

potential employers and service suppliers (as distinct
from the candidates, themselves) and provides its
meritorious functions of enhancing communications
independently of any particular techniques, automated
or otherwise, by which the actual matching operations
are performed.

Further, it is respectfully submitted that the
Examiner may have been somewhat confused by the
language used in the Decision on Appeal in regard to
possible obviousness of a single element of the
combination, *per se*. However, the Board of Appeals
and Interferences did not find any other claimed
elements to be taught or otherwise obvious in view of
Puram et al. and its statement cannot be construed to
even suggest that the subject matter of the claims
should be considered other than as a whole, as is
well-established as summarized in MPEP §2141.02. In
this regard and in view of these aspects of the
Decision on Appeal, it is respectfully submitted that
the fact that The Board of Patent Appeals and
Interferences did not, in fact (and quite correctly),
make a rejection of any claim under 37 C.F.R.
§1.196(b) under the circumstances and limited issues
involved in the Appeal, is a clear indication of
recognition by the Board of Patent Appeals and
Interferences that no rejection under 35 U.S.C. §103
was proper even though the particular element
dispositive of the issue under 35 U.S.C. §102 might be
deemed (but is not, in fact) obvious. Accordingly,
the Examiner's burden of making a *prima facie*
demonstration of obviousness is not reduced by the
Decision on Appeal and has clearly not been met as to
any recitation of any claim in the application.
Therefore Reconsideration and withdrawal of the
rejection of claims 1 - 7 is respectfully requested.

Since all rejections, objections and requirements
contained in the outstanding official action have been

fully answered and shown to be in error and/or inapplicable to the present claims, it is respectfully submitted that reconsideration is now in order under the provisions of 37 C.F.R. §1.111(b) and such reconsideration is respectfully requested. Upon reconsideration, it is also respectfully submitted that this application is in condition for allowance and such action is therefore respectfully requested.

If an extension of time is required for this response to be considered as being timely filed, a conditional petition is hereby made for such extension of time. Please charge any deficiencies in fees and credit any overpayment of fees to Attorney's Deposit Account No. 50-2041.

Respectfully submitted,

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